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EXAMINER

VU, NGOC K

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| ART UNIT | PAPER NUMBER |
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2611

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/608,819

Applicant(s)

KRAPP, RUSSELL M.

Examiner

Ngoc K. Vu

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Arguments

1. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent No. 6,425,128 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 9 of the patent recite the features of a video system comprising an input port; an output port; a preference engine; a storage device and a promotion module.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander (US 6,177,931 B1) in view of Picco et al. (US 6,029,045 A).

Regarding claims 1 and 12, Alexander discloses a video system and a method of operating a video system that receives video data that includes a plurality of premium contents, the system and method comprising:

an input port configured to receive video data including a plurality of premium contents (programs) (see col. 3, lines 1-25);

an output port configured to couple to a video display (monitor) for displaying video data selected by a viewer (see col. 3, lines 1-25);

a preference engine configured to track viewer selections of the video data and to create a viewer profile representing viewing preferences of a viewer (see col. 28, lines 11-21);

identifying at least one of the premium contents (programs) consistent with the viewer profile (see col. 31, lines 25-30); and

a promotion module responsive to the viewer profile to select one of the promotion content from the plurality of premium contents (selecting advertisement based on viewer profile), storing promotion content (advertising message) on a local storage device (e.g., RAM – see col. 33, lines 44-47) and retrieving a selected promotion content (e.g., ad for service) associated with the identified at least one of the premium contents and displaying the selected promotion content to entice the viewer to watch the associated at least one of the premium contents (for example, the system determines whether to notify the viewer about scheduling for a program involving the viewer's favorite team, a talk show involving a star player from that team. This feature includes displaying a customized notification or advertising message to entice the viewer to watch a particular program - see col. 32, lines 24-34).

Alexander does not explicitly disclose storing a selected promotion content on the local storage device. However, Picco discloses selectively storing one or content onto storage of the set top box to provide individualized content that may be inserted into the programming data

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stream (see col. 13, lines 36-40). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Alexander by selectively storing the content on the storage of the set top box as disclosed by Picco in order to save the space in the storage device for storing only the necessary data.

Regarding claim **2**, Alexander teaches the system comprising a set-top box or cable box coupled to the input port and configured to receive video data (see col. 3, lines 3-6 and 20-25).

Regarding claim **13**, Alexander discloses displaying the selected advertisement occurs upon determining that the viewer is watching video data displayed on a video display 10 (see col. 32, lines 35-39).

Regarding claim **14**, Alexander discloses displaying at least one of the programs corresponding to the selected advertisement upon the viewer selecting the displayed advertisement (see col. 5, lines 7-12; col. 4, lines 28-43).

Regarding claims **10** and **15**, Alexander discloses creating a plurality of viewer profiles, each viewer profile representing viewing preferences of a viewer and including preferred advertisements selected in accordance with the viewing preferences of the viewer (see col. 28, lines 11-29; col. 32, lines 23-34).

Regarding claims **11** and **16**, Alexander discloses selecting a viewer profile from a plurality of viewer profiles upon determining which viewer is likely to be watching at a given day and at given time using the viewing preferences (see col. 28, lines 22-46; col. 33, lines 36-43).

Regarding claims **3-5**, **7-9** and **17-23**, Alexander discloses recording program by VCR (see col. 5, lines 5-11). Alexander does not disclose the program including at least one conditional access video content. Official Notice is taken that video-on-demand or pay-per-view service for providing conditional access video content and descrambling the conditional access video content for the authorized viewer are well known in the television system. Therefore, it

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would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Alexander by including video-on-demand or pay-per-view service providing conditional access video content such as in order to enhance the television service, and descrambling the conditional access video content for the authorized viewer for security purpose.

Regarding claims **6** and **23**, Alexander discloses displaying of the selected advertisement as a scheduling information for a program (see col. 32, lines 27-34).

Regarding claims **24** and **26**, Alexander further discloses that the storage device comprises a VCR (see col. 3, lines 1-7; col. 4, lines 29-42).

Regarding claims **25** and **27**, Alexander further disclose the storage device comprises a hard disk drive (within PC – col. 3, lines 3-7).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu
Primary Examiner
Art Unit 2611

May 31, 2005